

REMARKS/ARGUMENTS

Applicants respectfully request reconsideration of the current application. Claims 1-31 are pending. No claims have been amended.

Double Patenting Rejections

The Examiner rejected claims 1-2, 4-27, and 29-30 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 4-5, 10, and 16 of U.S. Patent No. 6,711,565 filed by Applicants. A terminal disclaimer in compliance with 37 C.F.R. §1.321(c) is enclosed with this response to overcome the double patenting rejection. Applicants respectfully request the Examiner to withdraw the rejection.

Rejections under 35 U.S.C. § 101

Claims 1, 10, 16, and 21 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicants respectfully traverse the rejection. The Examiner argued that claims 1, 10, 16, and 21 recite an abstract idea in the preamble. Applicants respectfully disagree. The preambles of claims 1, 10, 16, and 21 recite "A method comprising:" and "A system comprising:", respectively. It is respectfully submitted that the preambles of claims 1, 10, 16, and 21 comply with well-known claim drafting format and they do not recite an abstract idea.

The Examiner further argued that "steps in the claim body merely applying a search and generating results, which can be implemented by a person or by the use of a pencil and paper" (Office Action, p.4, second paragraph). Applicants respectfully submit that the test under § 101 is not whether the claimed method (or system) can be

implemented by a person or by the use of a pencil and paper. As recited by the Examiner earlier in the Office Action, the two-prong test under § 101 is:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

Claim 1 is directed to performing a search based on at least the search criteria received from a user to identify certain data records. Unlike abstract ideas (e.g., mathematical algorithm, law of nature, etc.), data record searches are practical applications well-known in the area of information management. The search results (e.g., data records, etc.) produced by the claimed invention are useful, concrete, and tangible. Furthermore, the operations recited in claim 1, such as caching the search results to maintain the persistency of the search results, etc., clearly advance the technological arts by improving the data record search process in terms of speed and accuracy. Therefore, claim 1 is directed to statutory subject matter. Withdrawal of the rejection is respectfully requested.

For at least the reasons discussed above with respect to claim 1, claims 10, 16, and 21 are directed to statutory subject matter. Withdrawal of the rejection is respectfully requested.

35 U.S.C. § 103(a) Rejections

Examiner rejected claims 1-31 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,014,662 (hereinafter “Moran”) in view of U.S. Patent 6,292,802 (hereinafter, “Kessenich”). Applicants respectfully traverse the rejections.

Specifically, claim 1 includes the limitation, or a limitation similar thereto, of:

receiving search criteria entered by a user, wherein the search criteria includes at least one **search keyword**;
(Applicants' Independent Claim 1, ln. 2-3; emphasis added).

The Examiner admitted in the Office Action that Moran fails to disclose search criteria including at least one search keyword (Office Action, p.7, lines 10-12). However, the Examiner argued that Kessenich discloses keyword searching. The Examiner further argued that the general knowledge available to an ordinary skilled in the art is the use of keywords in the search, which can be found throughout Kessenich's reference (Office Action, pp. 8-9). It is respectfully submitted that the mere disclosure of one of the claimed limitations in an isolated reference or in the general knowledge of one of ordinary skill in the art does not provide motivation to one of ordinary skill in the art to combine the references. As stated by the Examiner, "obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is *some teaching, suggestion, or motivation to do so* found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art" (Office Action, p. 8, lines 16-20; emphasis added). The Examiner merely pointed to the disclosure of the entry of a keyword to be searched by a query request in Kessenich (Office Action, p. 9, lines 3-6). The Examiner did not point to any teaching, suggestion, or motivation in Kessenich for one of ordinary skill in the art to combine the references as proposed.

However, the Examiner alleged that Moran provides the motivation to modify the disclosure in Moran with the disclosure in Kessenich. In particular, the Examiner relied upon the search box in a window (shown in Figure 8 in Moran) that resulted from a prior search (Office Action, p. 9, lines 7-12). Applicants respectfully disagree with the

Examiner. The mere illustration of a search box does not provide any motivation to make the Examiner's proposed modification (e.g., advantages of the proposed modification, etc.). In fact, Moran does not even describe the search box in the related text. Contrary to the Examiner's assertion, Moran *teaches away* from such modification. According to Moran, text searching systems, which are based on searching for particular words, are difficult to use because it is difficult to formulate a precise search query (Moran, col. 1, lines 28-36). Moran further disclosed that the results generated by many text searching systems are unsatisfactory because such results are either overwhelming or incomplete (Moran, col. 1, lines 36-43). Therefore, the system proposed by Moran does not receive search criteria including at least one search keyword (Moran, col. 6, lines 31-33).

According to the Federal Circuit, a prior art reference must be considered in its entirety, i.e., as a **whole**, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983). It is improper to combine references where the references **teach away from their combination**. In re Grasselli, 713 F.2d 731, 743, 2187 USPQ 769, 779 (Fed. Cir. 1983). Since Moran explicitly states that systems based on searching for particular words are difficult to use, Moran *teaches away* from combining the system disclosed with keyword search capabilities. Therefore, under current case law, it is improper to modify Moran with the keyword search capabilities, such as the entry of keyword in a query request in Kessenich. As a result, claim 1 is patentable over Moran in view of Kessenich for at least this reason. Withdrawal of the rejection is respectfully requested.

For at least the reason discussed above with respect to claim 1, claims 10, 16, 21, and 27 are patentable over Moran in view of Kessenich. Applicants respectfully request withdrawal of the rejection.

Claims 2-9, 11-15, 17-20, 22-26, and 28-31 depend, directly or indirectly, from claims 1, 10, 16, 21, and 27. Therefore, claims 2-9, 11-15, 17-20, 22-26, and 28-31 are patentable over Moran in view of Kessenich for at least the reason discussed above with respect to claim 1. Withdrawal of the rejection is respectfully requested.

Furthermore, claims 3, 18, 23, and 31 are patentable over Moran in view of Kessenich for at least the following reason in addition to the reasons discussed above with respect to claim 1. Claims 3, 18, 23, and 31 sets forth the limitation, or a limitation similar thereto, of refining the search results based on at least one **result refining keyword** entered by the user. As discussed above with respect to claim 1, Moran teaches against the use of keyword to search. Furthermore, Kessenich fails to disclose such a limitation.

However, the Examiner insisted that Kessenich disclosed such limitation by the following:

Further, it will be recognized that linear search techniques within standard web browsers may be invoked to further refine the search of the information returned and displayed on the web browsers computer display screen. (Kessenich, col. 13, lines 29-33).

Kessenich merely discloses invoking *linear search technique* within standard web browsers to further refine the search of the information returned (Kessenich, col. 13, lines 29-33). Kessenich does not disclose refining the search results based on at least one **result refining keyword**. Invoking linear search technique within standard web browsers to refine search results is different from using result refining keyword entered by the user

to refine search results. Therefore, even if the disclosures of Moran and Kessenich are combined, the combination still lacks at least the above limitation. As a result, claims 3, 18, 23, and 31 are patentable over Moran in view of Kessenich for at least this additional reason. Applicants respectfully request the Examiner to withdraw the rejections.

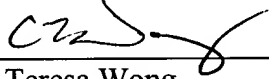
CONCLUSION

Applicants respectfully submit the present application is in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call C. Teresa Wong at (408) 720-8300, x377.

Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due.

Respectfully submitted,
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